

REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Summary of the Office Action

Examiner rejected claims 1-5, 12 under 35 U.S.C. § 103(a) as being unpatentable over Chrysanthakopoulos U.S. Patent 6,446,214 (hereinafter "Chrysanthakopoulos") in view of U.S. Patent 5,809,311 (hereinafter "Jones").

Examiner rejected claims 13 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chrysanthakopoulos in view of Jones and further in view of U.S. Patent 5,630,144 (hereinafter "Woog").

Examiner rejected claims 15, 17 and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Woog in view of Chrysanthakopoulos and further in view of Jones and further in view of U.S. Patent 5,978,922 (hereinafter "Arai").

Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Woog in view of Chrysanthakopoulos and further in view of Jones and further in view of Arai as applied to claim 15, and further in view of U.S. Patent 6,105,142 (hereinafter "Goff").

Response to 35 U.S.C. § 103(a) Rejections

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of

success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Office action relies on the combination of Chrysanthakopoulos with Jones in order to substantiate rejections of claims 1-23. It is submitted that such combination is improper, because there is no suggestion or motivation to combine these references.

Chrysanthakopoulos teaches away from “setting the power state of the autonomous subsystem based on the message, the setting of the power state exclusive of a main operating system,” as recited in claim 1.

In order to show a motivation to combine Chrysanthakopoulos with Jones, the Office action states that Jones' teaching of controlling other subsystem by the management controller independent from operating system would increase the flexibility of Chrysanthakopoulos' system by allowing the system to have *an additional controller for controlling the power subsystem, which is not required to be tracked by the operating system*. (Office action, p. 3.) However, Chrysanthakopoulos specifically points out the problems associated with localized power management and discloses a system that is intended to overcome such problems. In particular, Chrysanthakopoulos discloses the following:

Unfortunately, *localized power management causes a problem in that the operating system may not be aware of the device's current power state*. As an example, conventional storage devices have a local power manager that powers down the device to a sleep mode after a specified period of inactivity. The operating system, however, is left unaware of this power state transition. Accordingly, the operating system may still presume that the device is in a ready mode.

The operating system might alternatively attempt to poll the device to see if the storage device is ready and available, or the operating system might attempt to write some cached data to the medium. If the device is currently awake, it can

reply to the request or accommodate the cached data. However, if the device is currently asleep (unknown to the operating system), the status request or write operation initiated by the operating system causes the device to wake up before the request can be answered or the write operation performed. This can happen repeatedly if the device continues to power down on its own between each OS-initiated status request or write operation.

As a result, the operating system actually thwarts the local controller's efforts to minimize power consumption by routinely causing the device to change power states. Had the operating system known that the device was asleep, it would not need to send the status request or it would first wake up the device before trying to write cached data.

As is evident from the passage above, Chrysanthakopoulos teaches away from power management techniques where an operating system is unaware of power state transitions, and therefore teaches away from the feature of "setting the power state of the autonomous subsystem based on the message, **the setting of the power state exclusive of a main operating system,**" as recited in claim 1.

Because Chrysanthakopoulos teaches away from a feature recited in claim 1, it would not be obvious to a person of ordinary skill in the art to combine the teachings of Chrysanthakopoulos with Jones in order to arrive to the invention of claim 1.

The combination is improper because Chrysanthakopoulos and Jones are directed at distinct problems that manifest themselves during mutually exclusive situations

Chrysanthakopoulos directed at handling power state change requests *initiated by peripheral devices*. Thus, the peripheral devices in Chrysanthakopoulos have to be capable of initiating a request. In contrast, Jones is concerned with delivery of backup power to peripheral devices, (Jones, 3: 24-28), which is invoked in an event of interruption of the electrical power from the main power supply (Jones, 3: 5-6.), i.e., when a peripheral device is not capable of initiating a request. Since each reference discloses solutions to distinct problems, there is no motivation to combine Chrysanthakopoulos and Jones that can be found in the references themselves. Thus, a motivation to combine is found solely in the language of claim 1, and therefore the combination of Chrysanthakopoulos and Jones is improper.

The combination of Chrysanthakopoulos and Jones fails to disclose each and every element of claim 1

Even if these references are combined, the combination of Chrysanthakopoulos and Jones fails to disclose each and every element of claim 1. In Jones, a specific operation being performed independent of control of an operating system, is the operation of delivery of backup power. (Jones, 3: 24-28, 4: 44-49.) It is submitted that combining one reference teaching *a first operation being performed under the control of an operating system* with another reference teaching *an entirely different operation being performed independent of control of an operating system*, cannot possibly amount to the first operation being performed exclusive of a main operating system. Claim 1 recites a specific operation being performed exclusive of a main operating system. The specific operation is **“setting the power state of the autonomous subsystem based on the message that is received from the subsystem a message.”** Because, in Jones, an operation performed independent of control of an operating system is different from the operation performed exclusive of a main operating system required by claim 1, the disclosure of Jones is not relevant in the context of claim 1, and therefore the combination of Chrysanthakopoulos and Jones fails to disclose each and every element of claim 1.

Because the combination of Chrysanthakopoulos and Jones is improper, claim 1 and its dependent claims are patentable in view of Chrysanthakopoulos and Jones.

Claim 12 includes the feature of “determine a desired power state for the autonomous subsystem based upon received input signals and communications with the autonomous

subsystem, exclusive of a main operating system.” Thus, claim 12 and its dependent claims are patentable in view of Chrysanthakopoulos and Jones for at least the reasons articulated with respect to claim 1.

Claims 15 and 21 include the feature of “an autonomous subsystem coupled to the power state controller ... to operate exclusive of a main operating system.” Thus, claims 15, 21 and their respective dependent claims are patentable in view of Chrysanthakopoulos and Jones for at least the reasons articulated with respect to claim 1.

Claim 18 includes the feature of “means for determining a desired power state for the autonomous subsystem based upon the received input signals and communications with the autonomous subsystem, exclusive of a main operating system.” Thus, claim 18 and its dependent claims are patentable in view of Chrysanthakopoulos and Jones for at least the reasons articulated with respect to claim 1.

Examiner rejected claims 13 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chrysanthakopoulos in view of Woog. Woog, is directed at a desktop computer monitor power control using keyboard controller (Woog, Title.) Woog fails to disclose or suggest, whether considered separately or in combination with Chrysanthakopoulos and Jones, an autonomous system, for which a desired power state can be determined based upon the received input signals and communications with the autonomous subsystem, exclusive of a main operating system as required by claims 13 and 19 by virtue of them being dependent on claims 12 and 18 respectively. Thus, claims 13 and 19 are patentable and should be allowed.

Examiner rejected claims 15, 17, 21, 22, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Woog in view of Chrysanthakopoulos, Jones, and further in view of Arai. Arai, is directed at a computer system having resume function (Arai, Title.) Arai fails to disclose or suggest, whether considered separately or in combination with Chrysanthakopoulos, Woog, and Jones, “the autonomous subsystem to operate exclusive of a main operating system,” as required by claim 15. Claim 17 requires this feature by virtue of them being dependent on claim 15. Thus, claims 15 and 17 are patentable and should be allowed for at least the reasons articulated with respect to claim 1. Claim 21 requires “an autonomous subsystem ... to operate exclusive of a main operating system,” and therefore claim 21 and its dependent claims 22 and 23 are patentable for at least the reasons articulated above.

Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Woog in view of Chrysanthakopoulos, Jones and further in view Arai as applied to claim 15, and further in view of Goff. Goff, is directed at an intelligent power management interface for computer system hardware (Goff, Title.) Goff fails to disclose or suggest, whether considered separately or in combination with Chrysanthakopoulos, Woog, Arai and Jones, “the autonomous subsystem to operate exclusive of a main operating system,” as required by claim 16 by virtue of it being dependent on claim 15. Thus, claim 16 is patentable and should be allowed articulated above.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance

of the present application, the Examiner is invited to call Elena Dreszer at (408) 947-8200, x209.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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Elena B. Dreszer
Reg. No. 55,128

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026
(408) 947-8300